

REMARKS/ARGUMENT

1) Claims 1-8, 10-14, 16-20 and 22-26 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Rainish (Rainish et al., US Patent No.: 6,606,490 B1) in view of Eklund (Eklund et al., US Patent No.: 6,181,924 B1). Applicants respectfully traverse this rejection as follows:

Independent Claim 1, as amended, requires and positively recites a method of data communication between a base station and a mobile station over a wireless communication network, the method comprising the steps of: “transmitting data signals between a mobile station and a base station”, “monitoring the data signals received by the mobile station from the base station” and **“disabling the ability of the mobile station to transmit data signals to, while maintaining the ability of the mobile station to receive data signals from, the base station when the mobile station is in a shadow of the base station”**.

Independent Claim 10, as amended, requires and positively recites, a method of data communication between a base station and a mobile station over a wireless communication network, the method comprising the steps of: “transmitting data signals between a mobile station to a base station”, **“monitoring the signal to noise ratio (SNR) of data signals received by the mobile station from the base station to provide a determination whether the mobile station is in a shadow of the base station”** and **“disabling transmission of data signals from and maintaining reception of data signals by the mobile station when the mobile station is in a shadow of the base station”**.

Independent Claim 16, as amended, requires and positively recites, a method of data communication between a base station and a mobile station over a wireless communication network, the method comprising the steps of: “transmitting data signals between a mobile station and a base station”, “transmitting a signal from the base station to the mobile station that

indicates a loss of at least one primary base station rake finger to provide a determination that the mobile station is in a shadow of the base station” and “**disabling transmission of data signals by the mobile station while maintaining the ability of the mobile station to receive data signals** when the mobile station is in a shadow of the base station”.

Independent Claim 22, as amended, requires and positively recites, a method of data communication between a base station and a mobile station over a wireless communication network, the method comprising the steps of: “transmitting data signals between a mobile station and a base station”, “monitoring the data signals received by the mobile station from the base station”, “detecting an abrupt change in signal delay received by the mobile station from the base station to provide an indication of whether the mobile station is in a shadow of the base station” and “**disabling transmission of the data signals by the mobile station, while maintaining the ability of the mobile station to receive data signals transmitted by the base station**, when the mobile station is in a shadow of the base station”.

In contrast, the Rainish reference discloses a battery-powered portable radio receiver and method of operating the battery-powered radio receiver (Abstract, lines 1-2) in which, in contrast to the present invention, the receiver goes to sleep during predetermined time periods. In a Standby Mode, a receive path of the radio receiver is activated during a data-detection time interval for the detection of data destined for selected receivers, and a preconditioning time interval for performing pre-conditioning functions with respect to the receiver before the data-detection time interval (Abstract lines 4-9). Even the background of the invention, Rainish states:

In these terminals the Standby mode consists of a **relatively long “sleep” interval in which most of the terminal blocks of the mobile station are deactivated**, and a **relatively short “reception” interval in which the terminal is enabled to receive from the base station transmitted data**, usually a paging or a broadcast message, which may be intended for the terminal. The mobile station checks whether this

message is intended for itself, and according to its contests, decides an further actions, like going to the sleep phase ... (col. 1, lines 18-28).

Indeed, Rainish goes on to state in its “description of preferred embodiments of the present invention”, that “the present invention overcomes the disadvantages of the prior art, by providing a novel method which reduces the wake up time of the radio section as well as the baseband section” (col. 2, lines 64-67). As such, Rainish actually turns off its receiver, where as the present invention turns off the transmitter portion of the transceiver in the mobile station, but keeps the receiver portion on. As such, Rainish fails to teach or suggest, **“disabling the ability of the mobile station to transmit data signals to, while maintaining the ability of the mobile station to receive data signals from, the base station when the mobile station is in a shadow of the base station”**, as required by Claim 1, OR **“disabling transmission of data signals from and maintaining reception of data signals by the mobile station when the mobile station is in a shadow of the base station”**, as required by Claim 10, OR **“disabling transmission of data signals by the mobile station while maintaining the ability of the mobile station to receive data signals when the mobile station is in a shadow of the base station”**, as required by Claim 16, OR **“disabling transmission of the data signals by the mobile station, while maintaining the ability of the mobile station to receive data signals transmitted by the base station, when the mobile station is in a shadow of the base station”**, as required by Claim 22.

The Examiner relies upon Eklund to supplement the deficiencies of Rainish. Applicants respectfully submit that the Examiner seems to be misapplying the teaching of Eklund to the present invention. The Examiner states that Eklund teaches “the method of rejecting interfering signals”. But the present invention has nothing to do with rejecting interfering signals – it discusses signal-to-noise ratio (s/n) and structures that impact signal transmission. Even assuming, arguendo, Eklund discloses a method and system for rejecting interfering signals, Eklund does not teach or suggest the above-identified deficiencies of the Rainish reference. As such, any combination of Rainish and Eklund fails to teach or suggest the limitations of these claims and the 35 U.S.C. 103(a) rejection is overcome.

In proceedings before the Patent and Trademark Office, "the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art". In re Fritch, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (citing In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). "The Examiner can satisfy this burden **only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references**", In re Fritch, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992)(citing In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988)(citing In re Lalu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)).

Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. **The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.** In re Gordon, 733 F.2d at 902, 221 USPQ at 1127. Moreover, **it is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious.** In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed.Cir.1991). See also Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed.Cir.1985).

Furthermore, "all words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). It is clear from the above analysis that the Examiner did not consider all the words of Claims 1, 10, 16 and 22, as is required by law.

When all of the words of Claims 1, 10, 16 and 22 are considered as a whole, even where it proper to combine the Rainish and Eklund references, which it is not, all of the claimed elements are not disclosed in the combined teaching.

Claims 2-8, 11-14, 17-20 and 23-26 stand allowable as depending from allowable claims and including further limitations not taught or suggested by the references of record.

2) Claims 9, 15, 21 and 27 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Rainish (Rainish et al., US Patent No.: 6,606,490 B1) in view of Eklund (Eklund et al., US Patent No.: 6,181,924 B1) as applied to claims 7, 13, 19 and 25 above, and further in view of Bergins (Bergins et al., Patent No. 6,564,071 B1). Applicants respectfully traverse this rejection as follows:

Claims 9, 15, 21 and 27 depend directly or indirectly from Claims 1, 10, 16 and 22, respectively. Claims 9, 15, 21 and 27 are allowable for the same reasons given in support of the allowance of Claims 1, 10, 16 and 22. The Bergins reference fails to teach or suggest the previously discussed deficiencies of the Rainish and Eklund references.

Accordingly, Claims 1-27 stand allowable. New Claims 28-31 are similarly allowable. Applicants respectfully request allowance of the application as the earliest possible date.

Respectfully submitted,



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